

### **REMARKS**

Claims 1, 2, 4-17, and 19-23 remain in connection with the present application, with claim 1 being the sole independent claim.

### **Telephone Interviews**

Although the interviews were conducted via an exchange of voice mail responses from Friday, September 16<sup>th</sup> through Wednesday, September 21<sup>st</sup>, Applicants wish to thank the Examiner for this exchange of information. The content of this information exchange is as follows.

Initially, Applicants' representative contacted Examiner Laxton and pointed out that **Examiner Laxton did not fully consider all of Applicants' remarks** set forth in the Amendment of February 17, 2004 **with regard to various limitations added to claim 1**, with the exception of the resonance capacitor. Specifically, Applicants' representative acknowledged that the Examiner had changed the rejection of independent claim 1 from a rejection over the Reinhold et al. publication (EPO 820893, the Reinhold '893 publication), to a rejection over the Reinhold '893 publication in view of Laeuffer (U.S. Patent No. 6,324,080, the Laeuffer '080 patent). The Examiner acknowledged that the Reinhold '893 publication did not disclose a resonance capacitor, and added the Laeuffer '080 patent for allegedly providing such a teaching. **However**, as explained in the teleconference, **the remaining features of a common transformer including a single secondary winding and a single secondary converter connected to the single secondary winding, as set forth in claim 1, were not addressed**. Specifically, Applicants' representative again pointed out how the Reinhold '893 publication was deficient of these features, as well as the feature of the resonance capacitor.

**The Examiner**, in a subsequent telephone message, **acknowledged the deficiencies of the Reinhold '893 publication**, and indicated that the aforementioned features of claim 1 should have been considered to **overcome the Reinhold '893 publication** (alone or in combination with the Laeuffer '080 patent ) in the previous Office Action.

In an effort to potentially find allowable subject matter, however, the Examiner then reviewed additional prior art and alleged that Fig. 8 of a previously

cited article entitled “Influence of the control principle on a high-voltage inverter system for reduction of traction-transformer weight” (the “Influence” article) provided teachings of a common transformer including a single secondary winding and a single secondary converter connected to a single secondary winding. **The Examiner acknowledged that the aforementioned Fig. 8 of the article did not include the limitation of “wherein each primary winding of the common transformer is allocated one resonance capacitor”, but instead alleged that Fig. 8 of the Reinhold ‘893 publication made up for such a deficiency.**

Applicants’ representative acknowledged that the aforementioned article did not include at least the teaching of a resonance capacitor, and further disputed that the Reinhold ‘893 publication also taught or suggested such as resonance capacitor, alleging that the capacitors of Fig. 8 of the Reinhold ‘893 publication were instead AC voltage capacitors.

Subsequently, the Examiner acknowledged this deficiency of the Reinhold ‘893 publication, and then alleged that the Laeuffer ‘080 patent still provided some teaching of a resonance capacitor, and thus claim 1 might be rejectable over the aforementioned article, in view of the Laeuffer ‘080 patent. **As no formal rejection was made, no motivation for combining reference teachings was provided by the Examiner.** At that time, as no agreement of allowability was reached and as a deadline approached, Applicant’s representative decided to submit the present Response.

#### **Withdrawal of Previous Office Action Requested**

In view of the fact that the Examiner failed to consider Applicants’ remarks set forth in the Amendment of February 17, 2004, and in view of the fact that the teachings of a common transformer and a single secondary winding, as well as the aspects of a single secondary converter connected to the single secondary winding and each primary winding of the common transformer being allocated one resonance capacitor, are clearly not taught or suggested in the Reinhold ‘893 publication (taken alone or in combination with the Laeuffer ‘080 patent, even assuming *arguendo* that they could be combined, which Applicants do not admit), **the Examiner’s rejection under 35 U.S.C. § 103(a) is clearly not proper and must be withdrawn.** In addition, as the aforementioned arguments were never considered, **the finality of**

**the Examiner's Office Action must also be withdrawn**, and a new rejection (or a Notice of Allowance) must be issued.

Although the Examiner has mentioned the potential use of the aforementioned "Influence" article, potentially in combination with the Reinhold '893 publication and/or with the Laeuffer '080 patent, **no formal rejection has been made**. There has been no indication as to how many or which ones of the claims could and would be rejected, and **no motivation has been provided** by the Examiner for combining the prior art references.

Clearly, the Reinhold '893 publication was relied upon by the Examiner in an effort to reject many of the dependent claims. Thus, it is likely that the aforementioned "Influence" article, even if it could be taken in combination with the Laeuffer '080 patent, which is not admitted, **would still likely fail** to teach or suggest many of the limitations of **many of the dependent claims**. Accordingly, if the Examiner does choose to reject any of the claims over the aforementioned article, **the Examiner must make a formal rejection of each of these claims** in view of newly cited prior art, and **must withdraw the finality** of the current Office Action.

**THE LAEUFFER '080 PATENT IS NOT COMBINABLE WITH THE  
AFOREMENTIONED "INFLUENCE" ARTICLE OR THE REINHOLD '893  
PUBLICATION**

Even if the Laeuffer '080 patent did provide some type of teaching or suggestion of a resonance capacitor, which is not admitted, it is not even related to any type of bidirectional conversion and thus one of ordinary skill would not be motivated to combine its teachings with any of the references of record. Instead, it relates to the inversion of a DC voltage in order to obtain an AC voltage. It has nothing to do with dealing with high input voltage and is instead used in connection with X-ray tubes.

Thus, the **Laeuffer '080 patent would not provide any motivation** for one of ordinary skill in the art to combine its teachings with either those of the Reinhold '893 publication, or the article entitled "Influence of the control principle...traction-transformer weight". Both the Reinhold '893 publication and the aforementioned

“Influence” article deal with the handling of such high input voltage. In addition, neither of the Reinhold ‘893 publication and the aforementioned “Influence” article provides any teaching or suggestion of utilizing a resonance capacitor as claimed in claim 1 of the present application.

Especially with regard to the aforementioned “Influence” article, the Examiner would only be relying upon the last Figure (Fig. 8) of the publication, which apparently discusses some type of alternative configuration wherein the high voltage inverter is spilt into three converters. Thus, the “Influence” article clearly provides no teaching or suggestion, let alone any type of motivation, for utilizing or allocating one resonance capacitor to each primary winding of a common transformer.

Thus, none of the aforementioned references provide the necessary **evidence** of a teaching, suggestion or motivation for combining their teachings with those of the other references. If the Examiner is to make a new grounds of rejection, **Applicants note that absence such motivation, teaching or suggestion a prima facie case of obviousness under 35 U.S.C. § 103 cannot be established.**

To establish obviousness based on a combination of elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination which was made by the Applicant. The motivation, suggestion or teaching may come explicitly from one of the following:

- (a) statements in the prior art (patents themselves),
- (b) the knowledge of one of ordinary skill in the art, or in some cases,
- (c) the nature of the problem to be solved.

See In re Dembiczak, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

In order to establish *prima facie* case of obviousness under 35 U.S.C. § 103, the Examiner must provide **particular findings** as to why the two pieces of prior art are combinable. See Dembiczak, 50 USPQ2d at 1617. **Broad conclusory statements standing alone are not “evidence”.**

Combining prior art references without evidence of such a suggestion, teaching or motivation simply takes the Inventor’s Disclosure as a blueprint for piecing together the prior art to defeat patentability--the essence of hind sight. Dembiczak, 50 USPQ2d at 1617. Applicants respectfully submit that by **arbitrarily finding some type of resonance capacitor in the Laeuffer ‘080 patent, the Examiner is** doing just that; merely **utilizing Applicants’ claim 1 as a blueprint** and

then attempting to find all missing the pieces of a puzzle **without providing the necessary motivation or “instructions” for combining those pieces**. This is clearly an improper use of Applicants own invention, in hind sight.

If the Examiner is to maintain such a rejection, the Examiner must explain the **reasons why** one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious. See *In re Fritch*, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992). The Examiner can satisfy the burden of showing obviousness of the combination “only by showing **some objective teaching** in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references”. Relying on common knowledge or common sense of a person in ordinary skill in the art without any specific hint or suggestion of this in a particular reference is not a proper standard for reaching the conclusion of obviousness. See *In re Sang Lee*, 61 USPQ2d 1430 (Fed. Cir. 2002).

If the Examiner is relying on personal knowledge to support a finding of what is known in the art, the Examiner **must provide** an Affidavit or Declaration setting forth specific factual statements and explanations to support the finding. See 37 C.F.R. § 1.104(d)(2) and MPEP 2144.03(c).

### **Prior Art Rejections**

The Examiner has rejected claims 1, 2, 4-10, 12, 14-16, 19 and 21-23 under 35 U.S.C. § 103(a) as being unpatentable over the Reinhold ‘893 publication in view of the Laeuffer ‘080 patent. **This rejection is respectfully traversed for the reasons set forth above**; specifically that there is no motivation, teaching or suggestion for combining the teachings of the Laeuffer ‘080 patent with those of the Reinhold ‘893 publication, and for the reasons that the alleged combination (even assuming *arguendo* that they could be combined) would still fail to teach at least the limitations of a common transformer including a single secondary winding, and a single secondary converter connected to the single secondary winding, as well as each primary of the common transformer being allocated one resonance capacitor. Accordingly, withdrawal of the rejection is respectfully requested.

The Examiner has further requested claims 17 and 20 under 35 U.S.C. § 103(a) as being unpatentable over the Reinhold '893 publication in view of the Laeuffer '080 patent, and further in view of U.S. Patent No. 6,388,904 (the Nomura '904 patent). Again, the Examiner has not provided proper motivation for combining the Nomura '904 patent with either the Reinhold '893 publication or the Laeuffer '080 patent. In addition, even assuming *arguendo* that the references could be combined, which Applicants do not admit, the Nomura '904 patent would still fail to make-up for at least the previously mentioned deficiencies of the other references. Accordingly, withdrawal of the Examiner's rejection is respectfully requested.

#### **Entry of Amendment after Final**

Again, entry of the present Amendment is respectfully requested in that **the Examiner failed to consider various arguments previously set forth** and has acknowledged deficiencies of at least the Reinhold '893 publication, taken either singly or in combination with the Laeuffer '080 patent (even assuming *arguendo* that a combination could be made, which Applicants do not admit).

#### **Allowance Requested**

In view of the remarks above, **Applicants are hopeful** that the Examiner will withdraw each of the rejections, withdraw the finality of the rejection, and **allow each of the pending claims** in connection with the present application. Applicants have set forth the aforementioned additional remarks in hopes to avoid any further office actions.

#### **Interview**

If the Examiner believes that personal or telephonic communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the telephone number listed below.

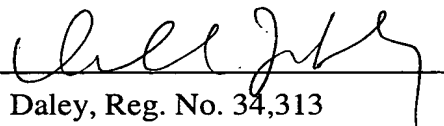
#### **CONCLUSION**

Accordingly, in view of the above amendments and remarks, reconsideration of the objections and rejections and allowance of each of pending claims 1, 2, 4-17 and 19-23 in connection with the present application is earnestly solicited.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

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